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U.S. - Supreme Court,  
**FILED**  
NOV 5 1945  
CHARLES ELMORE CRO  
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**In the Supreme Court of the United States**

**October Term, 1945**

**No. 500**

**ALBA TRADING CO., INC.,**

*Petitioner,*  
(Defendant below),

—against—

**MUSHER FOUNDATION, INC.,**

*Respondent,*  
(Plaintiff below).

**RESPONDENT'S BRIEF IN OPPOSITION TO  
PETITION FOR A WRIT OF CERTIORARI.**

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## **Respondent's Brief in Opposition to Petition for a Writ of Certiorari.**

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### **Statement of the Case.**

The patent in suit, No. 2,221,404 was applied for by Sidney Musher of New York, N. Y., and issued on November 12, 1940, to Musher Foundation, Inc., New York, N. Y., and this patent was sustained as to its two claims, a process claim and a product claim, by unanimous opinion of the Circuit Court of Appeals for the Second Circuit (Hon. Learned Hand) on July 18, 1945.

The Circuit Court of Appeals reversed the U. S. District Court for the Southern District of New York (Hon. John W. Clancy).

The petitioner has not put in evidence any prior art to rebut the presumption of validity of the patent.

The patent discloses an imitation olive oil made from corn oil by placing in such corn oil a paste of crushed dehydrated olives and after these crushed dehydrated olives are permitted to stay in the corn oil for a period of time, they are removed and the resultant corn oil not only takes on an unusual and unexpected strong olive aroma and flavor from the crushed olives which enable it to sell as an imitation olive oil, but it furthermore is highly stabilized against deterioration and rancidity which is an altogether unexpected result (R. pp. 30, 31, 51, 84).

While the treatment of the corn oil with crushed dehydrated olives may be carried out at room temperature according to the patent (p. 2, col. 2, line 19), in the preferred process as set forth in claim 1 on page 2 column 1, lines 53 to 59, the time of treatment of the corn oil with the ground olives may be shortened by using an elevated temperature for a shorter period of time (see patent R. p. 148).

The process set forth in the patent is carried out with dehydrated olives, but it may be carried out with salted or unsalted olives. The defendant-petitioner, Alba Trading Co., Inc., deliberately or because of lack of knowledge confuses the need for dehydration with salting at pages 16 and 23 of its petition.

Other imitation olive oils were on the market prior to and after the granting of the patent. It has been and still is quite customary to blend olive oil with a less expensive oil. For example, in a customary imitation olive oil 20% of olive oil is blended with 80% of corn oil (R. p. 32).

Other imitation olive oils are made by adding synthetic flavors (R. p. 32).

According to the patent in suit, the imitation olive oil, although practically entirely corn oil, was stable against deterioration and had a highly desirable flavor and aroma characteristic of natural olive oil (R. pp. 36, 37, 51, 80, 81 and 84) which gave considerable commercial success to the

patented imitation olive oil and enabled it to be sold through three licensees of plaintiff-respondent quite readily and widely in competition with other imitation olive oils during the period of 1940 to 1944.

The infringer, Alba Trading Co., Inc., the petitioner here, disregarding the possibility of securing a license, came into the market exactly copying the patented process and product, utilizing the procedure of treating the corn oil with dehydrated olive paste but merely making a trivial change in the preferred procedures set forth in the specification in lengthening the time of treatment by using a lower treating temperature.

The present petition does not fall within any of the categories covered by any rules of the United States Supreme Court since:

1. There is no conflict between decisions of different Circuit Courts of Appeals as to the patent.

2. There is no constitutional question involved.

3. There is no question as to difference between State and Federal law.

4. There is no great public interest in a monopoly in one form of imitation olive oil since respondent has given three licenses and is willing to license infringing petitioner and any others upon reasonable terms.

5. The public is not being deprived of imitation olive oil since other imitation olive oils not within the scope of the patent are now and have always been upon the market.

The patent contains only two claims, Claim 1 of which relates to the process and Claim 2 to the product. As sole reason for finding Claim 1 not infringed below, the District Court (Judge Clancy) assigned the omission of the defendant-petitioner to carry out the infusion of the macer-

ated olive paste at "a slightly elevated temperature" as stated in the claim. Judge Clancy held Claim 2 invalid for indefiniteness.

Therefore the only questions presented to the Circuit Court of Appeals for the Second Circuit and which the defendant-petitioner now seeks to have certified were

1. Does the defendant avoid infringement of claim 1 by carrying out the process described in the patent at room temperature for a longer period of time instead of "at a slightly elevated temperature" for a shorter period?
2. Is claim 2 so indefinite that it is impossible of construction as to what would constitute infringement?

The Circuit Court of Appeals for the Second Circuit in an unanimous opinion (Judge L. Hand) answered those questions in accordance with well settled rules of law and claim interpretation and reversed the District Court on both claims.

Since the defendant-petitioner was unable to discover any prior anticipatory art, its present request for a review of the judgment of the Circuit Court of Appeals for the Second Circuit is the equivalent of asking this Court to hold a patent invalid on its face without any substantial defences being offered.

### **Argument.**

There is little question that the patent in suit, No. 2,221,404, granted November 12, 1940, was infringed and the novelty of the patented subject matter is apparent since the infringer, Alba Trading Co., Inc., was unable to find any prior art or pertinent literature or patents which would in any way invalidate or even approach the patented procedure.

The infringer in defending this suit merely relied upon tenuous and technical defences involving

(a) minor variations from the preferred procedure set forth in process claim 1 of the patent, although utilizing a fully equivalent process and

(a) the contention that claim 2 which was exactly duplicated in its commercial procedures was indefinite. As Judge Learned Hand stated (R. p. 170) :

"The defendant did not put in any evidence of the prior art, but relied upon two points; that it did not infringe Claim One and that Claim Two was invalid for indefiniteness."

The Circuit Court of Appeals for the Second Circuit speaking through Judge Hand described the process of the patent as follows:

"The disclosure is for a process of making an imitation olive oil by infusing a 'glyceride' oil—such as cottonseed, or corn oil—with a 'macerated' paste made from dried olives; the first claim is for the process; the second for the product. \* \* \* This infusion is carried on 'preferably while the oil is at a slightly elevated temperature or such as is about 160° F. to 200° F. and desirably at about 175° F.' Thereafter the mixture is 'agitated' for 'from one minute to several hours;' and it is then filtered to take out 'undesired solids'."

The Court of Appeals pointed out that the only differences were, namely,

"two differences, and only two appear: the process is carried on at room temperature and not for a 'short time'."

It was pointed out by Judge Hand (R. p. 172) that

"The specifications speak of heating as in any case only 'preferred' during the infusion. Moreover,

when dried salted olives are added directly to the oil, and put through a colloid mill, no heat is necessary; and the period of subsequent 'agitation' can be entirely dispensed with, when the paste, after being thoroughly dispersed under heat, is put through such a mill. The undisputed testimony was that temperature and time are correlative factors in the infusion, as is generally the case in all chemical processes: i.e. the time may be shortened, if the temperature is raised, and must be lengthened, if it is not. Claim One selects, as the combination, 'a slightly elevated temperature' and 'a short time'; the defendant departs from this by using no heat but allowing the infusion to go on for three days at least."

It is clear that even with an extremely narrow range of equivalents this case would come directly under *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 41.

The Court of Appeals stated (R. p. 173) :

"There was absolutely no prior art; for the passing references in the testimony to earlier processes, on which the defendant relies, were totally inadequate under well settled law; moreover, the invention has had a very considerable success. Of course, the fact that verbally the infringing process is not within the claim is no objection to the application of the doctrine of equivalents; indeed it creates the very occasion which should evoke it. *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 41; *Claude Neon Lights v. Machlett & Son*, 36 Fed. (2) 574, 575 (C. C. A. 2); *Black & Decker Manufacturing Co. v. Baltimore Truck Tire Service Corporation*, 40 Fed. (2) 910, 914 (C. C. A. 4)."

The infringer, the petitioner herein, however, attempts to claim that the cancellation of three allowed claims (directed to using salted olives) for the purpose of transferring the subject matter to another application and to set up a clear line of division prevents the alleged in-



fringed process from coming within the process claim 1 of the patent in suit.

However, it is well known that in Patent Office procedure claims shifted from case to case; claims are cancelled to reduce the total number of claims, and claims are often cancelled or shifted to maintain clear lines of division between copending applications as was done in this case and in all these cases it is obvious that there is no estoppel or disclaimer actual or implied in cancelling claims.

Estoppels and disclaimers are only involved where claims are cancelled to avoid rejection upon prior art, prior patents, or prior publications and the Supreme Court cases cited in the brief in support of the Petition for Writ of Certiorari are all specifically directed to such instances. This is true of *United Carbon Co. v. Binney & Smith Co.*, 317 U. S. 228 (1942); *General Electric Co. v. Wabash Corp.*, 304 U. S. 364 (1937); *Schreiber Co. v. Cleveland Trust Co.*, 311 U. S. 211, 220 (1940), and *Leggett v. Avery*, 101 U. S. 256, 259 (1879).

There is no comparison between the situation in the present case and that where an actual disclaimer (not cancellation of claims) was filed in *Altoona Public Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477 (1935).

Judge L. Hand well disposed of this contention referring to *Smith v. Snow*, 294 U. S. 1, 14, 15; *Schreiber Co. v. Cleveland Trust Co.*, 311 U. S. 211, 220; *Exhibit Supply Co. v. Ace Patent Co.*, 315 U. S. 126, 136. Judge Hand stated:

"When an applicant cancels a claim which has already been allowed, none of this reasoning applies, and at best it becomes an open question which must be proved, whether he intends to surrender the disclosure in such sense that he abandons any equivalents of the elements of those claims which he keeps. Certainly no such intent was proved here."

In any case, the claims which were cancelled were more limited than the claims at present in suit since they were directed to salted olives as contrasted to unsalted olives which the infringer here claims were used. The Circuit Court of Appeals stated in this regard:

"All of them contained as an element that the paste or the olives must be salted; and the defendant does not salt the olives out of which it makes its paste. The applicant may well have cancelled the three claims in question precisely, because they did not include that 'much less preferable' alternative, which he had disclosed and claimed. We therefore hold Claim One entitled to the same range of equivalents as though the three claims had not been cancelled; and that, when the defendant lengthened the time and reduced the temperature, it adopted the equivalent of a 'short' time and a 'slightly elevated temperature'. *B. B. Chemical Co. v. Ellis*, 117 Fed. (2) 829, 833 (C. C. A. 1) was very close on the facts."

In any case, it has long been the rule that patents should be liberally construed so as to secure to an inventor the real invention which he intends to secure by his patent; furthermore, the specification may be referred to in order to explain any ambiguity in the claims, *Seymour v. Osborn*, 11 Wall (78 U. S.), 516, 547; *Railroad Co. v. Mellon*, 104 U. S. 112; *Westinghouse v. Boyden*, 170 U. S. 537.

It has also been held that temperature variations between defendant's process and that of the patent in suit do not avoid infringement if the same result is produced. *Tilghman v. Proctor*, 102 U. S. 707.

In respect to product claim 2 of the patent in suit, the defendant petitioner admitting that it comes squarely within the scope of the claim, attacks this claim upon the ground of indefiniteness although the defendant had no difficulty in exactly duplicating the subject matter thereof.

This claim describes the oil as being stabilized against rancidity or oxidative deterioration, as having novel flavor and odor characteristics derived from a paste of olives, and as being free of the fibers of olive ail.

Judge Hand in holding this claim 2 valid, stated (R. p. 175):

"Whatever may have been the recent tendency of the Supreme Court to bear more heavily than in the past upon indefiniteness of diction in claims, there can be no doubt, at least in the case at bar, that all the terms used in Claim Two are anchored in the specifications, and do not speak in terms of function—the only reason given for rejecting reference to the specifications in the last decision upon the subject. *United Carbon Co. v. Binney*, 317 U. S. 228, 234, 245 ('the description in the specification is itself almost entirely in terms of function' p. 236). To proceed to the details the specifications define 'substantially stabilized' in the following passage: 'materially improved in keeping quality, and it is frequently possible to extend the life of a glyceride oil by three or four times' (p. 2, col. 2, lines 12-14). ('substantially' is not of itself fatal to a claim; *Eibel Process Co. v. Minnesota & Ontario Paper Company*, 261 U. S. 45, 65: indeed, it must always be implied in every claim, even when not introduced, and adds nothing when it is. Were this not true, few patents could give any protection, for some departures from the precise disclosure are nearly always possible without losing the benefit of the invention.) The specifications several times describe the words 'novel flavor and odor' (p. 1, col. 1, lines 3 and 4; lines 26-34; p. 2, col. 2, lines 8-10; lines 26-28; lines 32, 33); indeed, they scarcely need any description, being themselves self-explanatory. Again, the specifications define the word 'small' by limits in specified percentage (p. 2, col. 1, lines 49-52; col. 2, lines 3, 4). Finally, 'substantially free of the fibres' means 'filtered' or 'centrifuged' (p. 2, col. 1, lines 60, 61; lines 74, 75). It is impossible to sup-

pose that anyone who really wished to respect the patent would have any difficulty in identifying what the claim covered. \* \* \* The claim describes a glyceride oil into which there has been infused those constituents, which will dissolve out of a specified proportion of a dry, macerated olive paste, all of which is to be found in the specifications. There is no ground whatever for supposing that *General Electric Company v. Wabash Appliance Corporation, supra*, 304 U. S. 364, meant to hold that the claim for a product may not be the claim for the product of the process described in the specifications. On the contrary that possibility appears to have been recognized: 'Even assuming that definiteness may be imparted to the product claimed by that part of the specification which purportedly details only a method of making a product, the description of the Pacz process is likewise silent as to the nature of the filament product' (p. 373). It was likewise implied in *Holland Furniture Co. v. Perkins Glue Co.*, 277 U. S. 245, 255, which was cited in the passage just quoted."

It is apparent that the Supreme Court cases urged by the petitioner do not support petitioner's position, namely,

*Holland Furniture Co. v. Perkins Glue Co.*,  
277 U. S. 245 (1927);  
*General Electric Co. v. Wabash Appliance Co.*, 304 U. S. 364 (1937);  
*United Carbon Co. v. Binney & Smith Co.*,  
317 U. S. 228 (1942).

In *Minerals Separation Ltd. v. Hyde*, 242 U. S. 261, 270-1, the Supreme Court of the United States stated:

"The certainty which the law requires in patents is not greater than is reasonable, having regard to their subject matter."

In *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, this Court sanctioned a limited use of terms of effect or result. It stated:

"A limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art, may in some instances be permissible and even desirable, but a characteristic essential to novelty may not be distinguished from the old art solely by its tendency to remedy the problems in the art met by the patent."

### Conclusions.

In view of the fact that:

there is no conflict between decisions of Courts of Appeals of different circuits;

there is no statute of the United States in question;

there is no great public interest in this subject matter involved in this suit (the petition does not even suggest in what manner the subject matter is alleged to be of great public interest or where it has any importance in the administration of the patent laws); and

the Circuit Court of Appeals for the Second Circuit has very ably answered the questions presented to it in accordance with old and established rules of law, this petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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New York, October, 1945.